REMARKS

In response to the rejection of claims 1-9 under 35 USC 101, Applicant has amended claim 1 so that the method is tied to another statutory class and therefore the rejection should be withdrawn. In response to the rejection of claims 19 under 35 USC 101, Applicant disagrees with the examiner because a record carrier is not an electromagnetic signal, but is a piece of media so that claim 19 is directed to statutory subject matter and the rejection should be withdrawn.

In response to the rejection of claims 1-2, 5-12 and 13-19 under 35 USC 112, second paragraph, Application has clarified that the claims relate to a method and apparatus for determining an inverse transform (and not the number of bits) and therefore the claims do not omit an essential element and the rejections are moot.

PRIOR ART REJECTIONS

In response to the rejection of claims 1-19 under 35 USC 103 as being unpatentable over US Patent Application Publication No. 2002/0164081 to Zhou ("Zhou Patent") in view of the "IDCT Output Range…" Article by Zhou et al. (the "Zhou Article"), Application traverses the rejection because the combination of the Zhou Patent and the Zhou Article does not disclose or suggest each claim element.

Claims 1 and 10

Claims 1 and 10 recite claim elements that are not disclosed by the combination of the Zhou Patent and the Zhou Article for the reasons set forth below.

Obtaining Sum of Coefficient Values and Comparing Sum to a Threshold Claim Elements

Claim 1 recites "obtaining, at an MPEG decoder, a sum of coefficient values within said transform coded data" and "comparing, in the MPEG decoder, this sum to a pre-determined threshold value." Claim 10 recites similar claim elements. These claims elements are not disclosed or suggested by the combination of the Zhou Patent and the Zhou Article.

The Zhou Patent (which the examiner relies on for disclosing these claim elements) discloses an image compression method in which the "Sum of Absolute AC coefficients (SM) for each 8X8 block in a macroblock" is computed. *See Zhou Patent at 0015*. The Zhou Patent uses the SM value to whether or not AC coefficients are quantized and coded by the VLC. *See Zhou Patent at 0015*. Thus, the Zhou Patent does not disclose that a sum of "coefficient values within said transform coded data" is obtained (both AC and DC coefficients) since the Zhou Patent only

discloses that a sum of the AC coefficients is determined. Furthermore, since the Zhou Patent does not disclose the claimed sum of the coefficient values, the Zhou Patent also does not disclose "comparing, in the MPEG decoder, this sum to a pre-determined threshold value." Thus, these claims elements are not disclosed by the Zhou Patent or the Zhou Article.

Deciding the Inverse Transform Implementation and Performing Claim Elements

Claim 1 also recites "deciding, in the MPEG decoder, as a consequence of said comparison which inverse transform implementation, out of a number of pre-determined implementations, should be performed when decoding said transform coded data" and "performing in the MPEG decoder on the transform coded data, the decided inverse transform." Claim 10 recites similar claim elements. These claims elements are not disclosed or suggested by the combination of the Zhou Patent and the Zhou Article.

The Zhou Patent (which the examiner relies on for disclosing these claim elements) discloses an image compression method in which an inverse discrete cosine transform (IDCT) is performed during video encoding to provide motion estimation/motion compensation. *See Zhou Patent at Figures 3 and 4.* However, the Zhou Patent does not disclose "deciding, in the MPEG decoder, as a consequence of said comparison which inverse transform implementation, out of a number of pre-determined implementations, should be performed when decoding said transform coded data" and "performing in the MPEG decoder on the transform coded data, the decided inverse transform" as set forth in claims 1 and 10. Thus, these claims elements are not disclosed by the Zhou Patent or the Zhou Article.

Thus, several claim elements are not disclosed or suggested by the combination of the Zhou Patent and the Zhou Article and the obviousness rejection should be withdrawn.

Claims 2-4, 6-9 and 11-13 and 15-19

These claims depend from independent claims 1 and 10 and these claims are not obvious over the combination the Zhou Patent and the Zhou Article for at least the same reasons as the independent claims.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-19 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

DLA PIPER LLP US

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